

REMARKS

On a preliminary note, the Examiner incorrectly stated that new claims 43-54 are pending in the application; however, the Applicant submitted new claims 43-56 in its last response.

In response to the Examiner's objection to the new claims for not being in proper format, i.e. underlined, new claims 43-56 have been underlined.

In response to the Examiner's rejection of the claims under 35 U.S.C. § 102(e) as being anticipated by Tabakoff, Applicant respectfully traverses. According to patent law, anticipation under § 102 "requires the presence in a single prior art disclosure of each and every element of a claimed invention." Lewmar Marine, Inc. v. Barient, Inc., 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, (Fed. Cir. 1987). Further, "every element of the claimed invention must be identically shown in a single reference." Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677, 7 U.S.P.Q.2d 1315, (Fed. Cir. 1988).

Independent claims 43, 47, 51, and 53 in the instant application each recites a method for preparing a compound comprising 4 steps wherein step (d) includes a 2-step process of reacting a 4-amino derivative first with triphosgene and then with a secondary amine. Tabakoff, on the other hand, teaches in step (d) a 1-step process of reacting a 4-amino derivative with diphenyl carbamoyl chloride. Since Tabakoff does not teach the 2-step process of reacting a 4-amino derivative first with triphosgene and then with a secondary amine and this limitation is recited in each independent claim, the § 102 rejection should be withdrawn. Notably, the Board of Patent Appeals and Interferences (BPAI) denied a proposed count (Count 2) drawn to the method of the Applicant and the

method of Tabakoff because it was not persuaded that the respective claimed methods interfered (see Paper 56: Memorandum Opinion and Order dated June 11, 2001).

Finally, Applicant includes herewith a declaration under 37 C.F.R. § 1.131 from inventor Alfred C. Nichols with exhibits evidencing that the Applicant reduced its synthesis method to practice prior to the earliest priority date available to Tabakoff (June 6, 1997). The attached declaration shows that the Applicant conceived of its method on or about February 15, 1994, initiated a series of syntheses according to its method on March 23, 1994, and obtained evidence indicating that the method successfully produced the expected 4-urea derivatives. Actual reduction of the method to practice has been shown in each of the referenced April 11, 1994, May 3, 1994, July 1, 1994, and July 13, 1994 syntheses. Products from each of these syntheses were tested according to standard identification procedures that indicated that the compounds are indeed 4-urea derivatives and, therefore, the method has been shown to have been successfully reduced to practice prior to the earliest priority date available to Tabakoff.

In light of the foregoing, the Applicant respectfully requests the Examiner withdraw the objection and rejection and allow the application. Should the Examiner have additional matters to be resolved, the Examiner is invited to telephone the undersigned to expedite resolution of the case.

Respectfully submitted,



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